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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,826	07/03/2001	Stephen Michael Reuning	Diedre/Candidate	3851

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EXAMINER

RIMELL, SAMUEL G

ART UNIT PAPER NUMBER

2175

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,826

Applicant(s)

REUNING, STEPHEN MICHAEL

Examiner

Sam Rimell

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ ~~Claim(s) 4, 5 is/are allowed.~~
- 6) ☒ Claim(s) 1-3 and 6-19 is/are rejected.
- 7) ☒ Claim(s) 4, 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

SAM RIMELL
CHIEF EXAMINER

Claims 9-12 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9: The phrase "as many linking levels as desired" is indefinite since it is not clear whether it would encompass one level, multiple levels, or no levels at all.

Claim 11: The phrase "advanced natural language screening technology" is indefinite. It is not clear what kinds of systems this would encompass.

Claim 16: See remarks for claim 9.

Claim 18: See remarks for claim 11.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 6-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor ('497).

Claim 1: The reference to Taylor discloses an iterative search engine (106) which reads as a filter which can locate web pages from a database of records. The reference refers to the Monster.com website (col. 6, lines 58-60) in which e-mail addresses are presented as hyperlinks. Clicking on such a hyperlink pops up an e-mail system which extracts the e-mail address and creates an email to be sent to the e-mail address spelled out by the hyperlink. This e-mail system thus serves as an e-mail extractor. No patentable weight is attributed to the intended usage of the filter for searching web pages.

Claim 6: In Taylor, the iterative search engine (106) locates a web page. Clicking on a hyperlinked e-mail address pops up an e-mail system that extracts an e-mail address for creating an e-mail to be sent to the address spelled out in the hyperlink.

Claim 7: The pop up e-mail system used on Monster.com is for the purpose of sending an e-mail.

Claim 8: Since Monster.com is a dedicated site for employment opportunities, the e-mail created by the pop-up system would inherently be related to a job opportunity.

Claim 9: This claim is broad enough to allow for extraction of e-mail from zero linking levels, and thus reads on Taylor, which does not extract e-mails beyond the ones presented directly to the user.

Claim 10: The iterative search engine searches a database using a keyword.

Claim 11: Since the keywords are natural language, the iterative search engine performs its query processing based on a processing of natural language.

Claim 12: All query processing involves application of rules.

Claim 13: See remarks for claim 1.

Claim 14: See remarks for claim 7.

Claim 15: See remarks for claim 8.

Claim 16: See remarks for claim 9.

Claim 17: See remarks for claim 10.

Claim 18: See remarks for claim 11.

Claim 19: See remarks for claim 12.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Official Notice.

Taylor differs from claims 2-3 in that it does not disclose relevancy scoring. However, Examiner takes Official Notice that relevancy scoring for search results is very well known in the art of database searching. It would have been obvious to one of ordinary skill in the art to modify Taylor to include relevancy scoring of results to reduce the need to review a large number of hits as is very well known in the art.

Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Remarks

Applicant's arguments have been considered.

Rejection under 35 USC 112 of claims 9 and 16 in reference to the phrase "linked web pages": Applicant's arguments are persuasive on this point, and the rejection has been vacated.

Rejection under 35 USC 112 of claims 9 and 16 in reference to the phrase "As many linking levels as desired": Examiner maintains that this phrase is indefinite. First of all, it is not clear what would be considered to be "desired" or "desirable". Secondly, the scope of the claim cannot be precisely determined since it is not clear how many levels (if any) would meet the requirements of the claim.

Rejection under 35 USC 112 of claims 11 and 18 in reference to the phrase "Advanced Natural Language Screening Technology": Examiner maintains that this phrase is indefinite, since it is not clear exactly which technologies are encompassed by this phrase. Applicant argues that in deciding the Petition to Make Special, the Petitions Examiner ruled that this phrase was statutory. However, the Petitions Examiner did not make such a ruling. When considering a Petition to Make Special, the Petitions Examiner does not make judgment on whether the claims are definite under 35 USC 112, or statutory under 35 USC 101.

Rejection of claims 1 and 6-19 under 35 USC 102(e) as being anticipated by Taylor ('497):

Examiner maintains that this rejection is proper. Applicant argues that the Examiner erred in finding that patentable weight could not be attributed to the intended usage of the filter to search web pages. However, MPEP 2106, Section C, explicitly permits the Examiner to raise

questions of the limiting effect of claim language when that claim language is directed to an intended use.

With respect to the Taylor reference itself, applicant argues that Taylor lacks an extraction mechanism for extracting an e-mail addresses. Examiner maintains that Taylor's existing e-mail system reads as the extractor. Examiner is not stating that this feature is an obvious modification, but rather, that it anticipated by Taylor. This feature derives from the incorporation by reference of the Monster.com website (col. 6, lines 58-60), in which e-mail addresses are presented to the user in the form of hyperlinks. When the user clicks the hyperlinked address, the e-mail address is extracted and used to set up an e-mail with the user's own e-mail system. Thus, the user's e-mail system effectively functions as an e-mail extractor when the user is accessing the Monster.com website.

Rejection of claims 2-3 under 35 USC 103 as having been obvious in view of Taylor ('497):

Examiner maintains that this rejection is proper. Applicant argues that the examiner's finding of obviousness on the basis of Official Notice is "illegal" and inconsistent with prevailing case law. However, MPEP 2144.03 explicitly permits Examiners to take Official Notice of facts which are outside of the record. Specifically, this section states:

"The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well known" prior art. The Examiner may take Official Notice of facts outside of the record which are capable of instant and unquestionable demonstration as being well known in the art. In re Ahlert 424 F.2d 1088, 1091 , 165 USPQ 418, 420 (CCPA 1970)."

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2175